A. Preliminary Matters

Claims 1-5, 9-10, 15-20, 24-25, 28-33 and 36 were provisionally rejected under the judicially created doctrine of double patenting over claims 6-10, 12-16, and 18 of co-pending Application No. 09/106,659. It is the Examiner's position that a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) must be submitted in order for the non-statutory double patenting rejection to be removed from the record. As the present application is a continuation-in-part of Application No. 09/106,659, Applicants respectfully traverse this requirement.

The present application is a continuation-in-part of, and claims the benefit of, U.S. Patent Application No. 09/106,659, filed June 29, 1998. (See page 1, lines 4-5.) The term of a patent is twenty (20) years measured from the filing date of the earliest U.S. application for which benefit is claimed. MPEP §201.11. For a continuation-in-part application, this standard applies to all claims regardless of whether the particular claim may properly be awarded the filing date of the earlier application. As such, any patent which may issue based upon the present application will expire twenty (20) years from the filing of Application No. 09/106,659. It is Applicants' belief that a terminal disclaimer is not proper in this circumstance as there is no term for a patent which may issue based upon the present application that would extend beyond the term for a patent which may issue based upon Application No. 09/106,659. It is unclear to Applicants exactly what they are being asked to disclaim. Withdrawal of the non-statutory double patenting rejection accordingly respectfully is requested. Alternatively, clarification is respectfully requested.

All rejections set forth in the final Office action dated February 27, 2001 have been rendered moot due to the cancellation of claims 1-40.

B. Each of newly added claims 41-44 is believed to be in condition for allowance.

1. Claims 41-44 are adequately supported by the specification as filed.

Claims 41 and 43 are the independent claims which remain in the present application. Claim 41 recites a method of playing a group participation wagering game in combination with an individual participation wagering game which comprises forming a group of a plurality of entrants, determining whether a winning outcome is achieved in the individual participation wagering game and, if so, determining an individual prize amount associated therewith, allocating a multiplier value from a plurality of multiplier values to the group participation game and determining a total prize amount for each entrant which is equal to the entrant's individual prize amount multiplied by the multiplier value. Each entrant must make a wager on an outcome of the individual participation wagering game and an additional wager to participate in the group participation wagering game. The multiplier value allocated to the group participation wagering game is allocated from a plurality of multiplier values capable of being applied to the individual prize amount. Each entrant who achieves a winning outcome in the individual participation wagering game and who also wagered in the group game is guaranteed to have the multiplier value applied to the entrant's individual prize amount.

The combination individual and group participation wagering game as well as the guaranteed multiplier concept recited in claim 41 are adequately supported by the specification as filed. At page 6, lines 15-16, it is stated that "[i]n accordance with multiple embodiments of the preferred game, the group game is combined with an individual participation [] game." At page 7, lines 13-15, it is stated that an individual game is combined with the "group game of the present invention by allowing an individual to enter the group participation game at the same time he or she enters" the individual game. At page 4, lines 15-17, it is stated that "[t]he award given in the group game is preferably in the form of a multiplier of the winning outcomes of another game, such that a player receives, for example, one times, two times, three times or any other multiple of his or her winnings in the other game." At page 10, lines 3-5, it is stated that an embodiment of the invention comprises a game which "includes randomly generated indicia displayed to the players as payout multipliers on a

wheel." Further, at page 10, lines 9-11, it states that a "wheel is spun and all the participants collectively anticipate whether the designator will point to a payout multiplier."

Claim 42 is dependent upon claim 41 and recites that a plurality of individual prize amounts are determined and each individual prize amount is multiplied by the multiplier value. This, too, is amply supported by the specification as filed. Throughout the specification, particular reference is made to the difference between an individual and a group participation game. By definition, an individual game is played by a single individual and a group game is played by a group of individuals. There is no requirement in the claims or the specification that each individual's wager be equivalent. As the individual prize amount is clearly described as relating to the individual's wager amount, it stands to reason that the individual prize amounts will vary amongst individuals. Further, because there is also a group game, it is clearly suggested that there must be more than one individual. Thus, it is clear that each individual participating in the group game, participation in which requires a winning outcome in an individual game, will have a separate, potentially unequivalent, individual prize amount. That each of these amounts will be multiplied by the multiplier value is clear.

Claim 43 recites a method of making a wager on an outcome of the first wagering game and an additional wager on an outcome of the second wagering game, the two wagering games being independent of one another. The method comprises making a wager thereby enabling a player to participate in the first wagering game, determining whether the outcome of the second wagering game comprises a winning outcome for the player and, if so, determining a prize amount associated therewith, allocating a multiplier value to the first wagering game and determining a total prize amount for the player in the first wagering game which is equal to the player's prize amount won in the second wagering game multiplied by the multiplier value. Each multiplier value is allocated from a plurality of multiplying values capable of being applied to the prize amount won in the second wagering game

and the player is guaranteed to have the multiplier value applied to a prize amount won in the second wagering game.

The recited combination of first and second wagering games and multiplier of the prize amount are amply supported by the specification. The particular embodiments described in the specification merely in an exemplary fashion, teach a group game and an individual game. By definition, this combination represents a first and a second wagering game. It is clear from the specification, however, that it was not Applicants' intent to limit the present invention to a group game in combination with an individual game. Rather each example is clearly intended to be only by way of example. As for the multiplier concept, support in the disclosure is ample. For example, at page 4, lines 15-17, it is stated that "[t]he award given in the group game is preferably in the form of a multiplier of the winning outcomes of another game, such that a player receives, for example, one times, two times, three times or any other multiple of his or her winnings in the other game." At page 10, lines 3-5, it is stated that an embodiment of the invention comprises a game which "includes randomly generated indicia displayed to the players as payout multipliers on a wheel." Further, at page 10, lines 9-11, it states that a "wheel is spun and all the participants collectively anticipate whether the designator will point to a payout multiplier."

Claim 44 is dependent upon claim 43 and recites that upon receiving a winning outcome in the second game, each entrant is guaranteed to have a multiplier value applied to the prize amount won in the second game irrespective of whether each entrant achieved a winning outcome in the first wagering game. This claim is also well supported by the specification as filed. There is no requirement recited in either the specification or the claims for a winning outcome to be achieved in both games in order for a player to apply the multiplier value to his or her winnings earned in one of the games.

Accordingly, each of newly added claims 41-44 is supported by the specification as filed.

2. The prior art of record neither anticipates nor renders obvious newly added claims 41-44.

The following references represent the pertinent prior art of record in the present application: U.S. Patent No. 5,830,063 to Byrne; U.S. Patent No. 5,393,057 to Marnell, II; U.S. Patent No. 5,112,050 to Koza et al.; U.S. Patent No. 5,772,509 to Weiss; and U.S. Patent No. 5,833,537 to Barrie. As none of these references anticipates or renders obvious the present invention, nor is the present invention rendered obvious by any combination of these references, Applicants believe newly added claims 41-44 to be in condition for allowance. Such favorable action respectfully is requested.

a. U.S. Patent No. 5,830,063 to Byrne

Byrne neither teaches nor suggests a method of making a wager on an outcome of the first wagering game and an additional wager on an outcome of a second wagering game wherein the winnings of one game are guaranteed to be multiplied by a multiplier value allocated to the other game as recited in newly added claims 41-44. Byrne discloses a "collateral gambling game" which is a group game to be played in association with an individual principal game. Specifically, Byrne discloses a collateral group game, generally referred to as "Super Keno", in which players may make an additional wager on the outcome of an individual or "standard keno" game played by any one of a number of different players. In Byrne, both games are not required to be played. If any player playing the standard keno game wins their individual game, during the game in which the Super Keno entries are valid, any player who placed a wager in the Super Keno game also wins. Winnings for the Super Keno game are distributed from a different jackpot pool than the standard Keno winnings.

The collateral game of Byrne neither teaches nor suggest that the winnings in one game will be multiplied by a multiplier value allocated to the other game to achieve a total prize amount as disclosed in each of claims 41 and 43. As such, Byrne does not teach or suggest that which is recited

in these claims. As claims 42 and 44 each depend from one of claims 41 or 43, Byrne also does not anticipate nor render obvious that which is recited in these claims.

b. U.S. Patent No. 5,393,057 to Marnell, II

Marnell, II neither teaches nor suggests a method of making a wager on an outcome of the first wagering game and an additional wager on an outcome of a second wagering game wherein the winnings of one game are guaranteed to be multiplied by a multiplier value allocated to the other game as recited in newly added claims 41-44. Marnell, II discloses an electronic gaming apparatus and method involving an electronic individual gaming device and an electronic group gaming device electrically coupled to one another. The individual gaming device is responsive to the occurrence of selected events for input into the group gaming device. Thus, play and selection in the group game is dependent upon the occurrence of specified events in one or more of a number of individual games. As such, the results of the primary game (individual gaming device) enable the play of the secondary game (group gaming device).

Marnell, II neither teaches nor suggests that the winnings in one game will be multiplied by a multiplier value allocated to the other game to achieve a total prize amount as disclosed in each of claims 41 and 43. As such, Marnell, II neither anticipates nor renders obvious that which is recited in newly added claims 41 and 43. As claims 42 and 44 each depend from one of claims 41 or 43, Marnell, II also does not anticipate nor render obvious that which is recited in these claims.

c. U.S. Patent No. 5,112,050 to Koza et al.

Koza et al. neither teaches nor suggests a method of making a wager on an outcome of the first wagering game and an additional wager on an outcome of a second wagering game wherein the winnings of one game are guaranteed to be multiplied by a multiplier value allocated to the other game as recited in newly added claims 41-44. Koza et al. discloses a broadcast lottery game in which winning information is broadcast over a medium and received by a game ticket. A player acquires a ticket for

a given game. Resident within or on the ticket is a stored value, e.g., a number. At some stage of the game, a winning value is designated. This winning value is broadcast over a medium, such as by radio frequency transmission. Each ticket includes a receiver for receiving the broadcast message containing the winning value and each ticket has the ability to determine whether the stored value that has been assigned to that ticket is entitled to win a prize. If appropriate, the ticket gives sensory information to the player, informing the player that he or she is a winner in the game.

Koza et al. neither teaches nor suggests that the winnings in a first game will be multiplied by a multiplier value allocated to the other game to achieve a total prize amount as disclosed in each of claims 41 and 43. As such, Koza et al. neither anticipates nor renders obvious that which is recited in newly added claims 41 and 43. As claims 42 and 44 each depend from one of claims 41 or 43, Koza et al. also does not anticipate nor render obvious that which is recited in these claims.

d. U.S. Patent No. 5,772,509 to Weiss

Weiss neither teaches nor suggests a method of making a wager on an outcome of the first wagering game and an additional wager on an outcome of a second wagering game wherein the winnings of one game are guaranteed to be multiplied by a multiplier value allocated to the other game as recited in newly added claims 41-44. Weiss discloses an instrumentality and method directed to an interactive gaming system in which a plurality of first gaming machines are in operative communication with a second gaming machine. The outcome from the plurality of first gaming machines may allow one or more players at these machines to participate in a further opportunity to be awarded a prize on the second gaming machine. Once an individual player qualifies to play on the second gaming machine, an opportunity of winning on the second machine exists according to a series of outcomes determined by a random number generator.

Weiss neither teaches nor suggests that the winnings in one game will be multiplied by a multiplier value allocated to the other game to achieve a total prize amount as disclosed in each of

claims 41 and 43. As such, Weiss neither anticipates nor renders obvious that which is recited in these claims. As claims 42 and 44 each depend from one of claims 41 or 43, Weiss also does not anticipate nor render obvious that which is recited in these claims.

e. U.S. Patent No. 5,833,537 to Barrie

Barrie neither teaches nor suggests a method of making a wager on an outcome of the first wagering game and an additional wager on an outcome of a second wagering game wherein the winnings of one game are guaranteed to be multiplied by a multiplier value allocated to the other game as recited in newly added claims 41-43. Barrie discloses a gaming apparatus and method in which players are motivated to play multiple rounds of play by the presence of an indicator or symbol which persists between successive rounds of play and, preferably, can affect the reward for a winning game outcome. In other words, Barrie discloses a gaming apparatus and method in which not all reward-affecting symbols (e.g., cards in keno or blackjack, or symbols on a slot machine) change from one round of play to the next. In one embodiment, Barrie discloses a slot machine wherein each potential winning line displays a multiplier which is permanently affixed to the machine and does not vary with play. If a winning outcome is achieved in a winning line for which there is affixed a multiplier symbol, the player's winnings will be multiplied by the numerical value assigned the multiplier symbol.

Barrie neither teaches nor suggests that the winnings in one game will be multiplied by a multiplier value allocated to a second game to achieve a total prize amount as disclosed in each of claims 41 and 43. Rather, the multiplier disclosed in Barrie merely represents a value by which a single game's winnings may be multiplied. There is no second game involved nor is there any suggestion that the multiplier be applied to a secondary game. The intent of the Barrie multiplier is to increase the number of rounds a single player plays by offering the potential of higher individual winnings. The Barrie reference discloses a method for motivating players to continue to play a single game rather than moving on to a second game. The present invention, on the other hand, encourages play of second game

so that the winnings in the first game may be multiplied. As such, Barrie neither anticipates nor renders obvious that which is recited in newly added claims 41 and 43. As claims 42 and 44 each depend from one of claims 41 or 43, Barrie also does not anticipate nor render obvious that which is recited in these claims.

f. The above-cited references are not properly combinable nor would any combination of these references suggest the present invention.

Applicants respectfully submit that a prima facie case of obviousness for rejecting any of pending claims 41-44 under § 103 could not have been established based upon the above-cited references as these references are not properly combinable. The United States Patent and Trademark Office has the burden of establishing a prima facie case of obviousness. This burden is not met unless "'the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" In re Bell, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051 (C.C.P.A. 1976)). Applicants respectfully submit that a § 103 rejection of any of pending claims 41-44 based upon these references would be based upon an improper combination. Further, any combination of the above-cited references would fail to suggest the claimed invention.

It is well settled that a reference cannot be modified unless the reference teaches or suggests the desirability of the modification. As stated in the MPEP, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." § 2143.01. See In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990) ("there must be a suggestion or motivation in the reference" to modify it); In re Jones, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992) ("[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art."). "Obviousness cannot be established by combining the teachings of the

prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital Systems, Inc. v. Monteffore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). If there is no technological motivation for modifying a reference and/or if there is a disincentive for doing so, then a § 103 rejection based upon the reference is not proper.

The above-cited references provide no suggestion or motivation to combine and thus the the burden of establishing a prima facie case of obviousness could not be met with regard to these references. Even assuming, arguendo, that the above-cited reference may be properly combined, any resulting combination would not disclose the claimed invention. As such, Applicants respectfully submit that no combination of the above-cited references would render the present invention obvious.

g. The synergy between first and second games taught by the present invention offers economic advantage to the gaming industry.

The present invention offers tremendous incentive to players to participate in a base game. In order to play in a multiplier game, a game in which each player is guaranteed to have his or her winnings from the base game multiplied, the player must wager on both the base game and the multiplier game. Upon achieving a winning outcome in the base game, the player is guaranteed to have his or her winnings multiplied, provided he or she made an additional wager to participate in the multiplier game. Thus, the winning potential of each player in the base game is dramatically increased by payment of a modest additional wager. Because of this increased winning potential, more players will be attracted to and play the base game.

The synergy between the base game and the multiplier game, in which the rewards of the base game are multiplied by the results of the multiplier game, offers great economic advantage to the gaming industry. The present invention offers a method that encourages players to increase both their wager amounts and their frequency of play.

C. Conclusion.

Each of newly added claims 41-44 is directed to a method of playing a first wagering game in combination with a second wagering game wherein the winnings in one game will be multiplied by a multiplier value allocated to the second game to achieve a total prize amount. Each of these new claims is believed to be novel and unobvious in light of the prior art and each of the claims is believed to be in condition for allowance. Such favorable action respectfully is requested.

Should any unresolved issues remain, please feel free to contact the undersigned at the phone number listed below.

Respectfully submitted,

William B. Kircher
Reg. No. 22,481

WBK/sjm
SHOOK, HARDY & BACON L.L.P.
One Kansas City Place
1200 Main Street
Kansas City, Missouri 64105-2118
816/474-6550